

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-15, 17-19, 21-23, and 25-28 are presently active in this case, Claims 1, 3-14, 18, and 22 having been amended and Claims 26-28 having been added by way of the present Amendment. Care has been taken such that no new matter has been entered by the amendments set forth herein.

In the outstanding Official Action, Claims 1-4, 6, 7, 9, 10, 12, and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (U.S. Patent No. 6,034,832) in view of Berman et al. (U.S. Patent No. 6,502,194). Claims 5, 8, and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. in view of Berman et al. and further in view of Epstein (U.S. Patent No. 6,601,046). Claims 14, 15, 17-19, 21-23, and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. in view of Berman et al. and further in view of Mori et al. (U.S. Patent No. 6,208,802). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either

when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent Claims 1, 3, 4, 14, 18, and 22.

Claim 1 of the present application recites an information processing apparatus having functions for recording contents recorded on a first recording medium onto a storage unit of the apparatus. The apparatus comprises recording unit for recording the contents of the first recording medium onto the storage unit, storing unit for storing information regarding each track on the first recording medium as recording history information in the apparatus at the time the contents of the first recording medium are recorded onto the storage unit by the recording unit, determining unit for determining whether a track on the first recording medium was previously recorded or not onto the storage unit by the recording unit based on the recording history information stored in the apparatus, and display control unit for controlling display of information regarding a track that was not previously recorded as determined by the determining unit, wherein the display control unit initially indicates the track that was not previously recorded as being selected for recording by the recording unit from the first recording medium to the storage unit. Similar features are recited in Claims 3 and 4. The Applicants submit that the cited reference, either when taken singularly or in combination, fail to disclose or suggest the above features.

By way of illustration and not limitation, the present application advantageously provides an invention in which an audio recording managing unit (101) searches audio recording history information in stored memory, and judges whether or not audio recording history of each of the tracks of a CD exist in the memory. (See step S4 in Figure 6 and corresponding description in the specification.) As noted in Figure 7, the recording managing

unit compresses the contents read out from the CD with a predetermined format, encrypts, and outputs to the music piece managing unit. The music piece managing unit stores rights information in rights storing unit, and registered encrypted contents in the database. The music piece managing unit stores encrypted contents in a music piece file storing unit, and the recording managing unit changes the recording history information. The features regarding the storing of the contents of the first recording medium on to a storage unit of the apparatus are not disclosed or suggested in the cited references.

The cited references, either when taken singularly or in combination, fail to disclose or even suggest recording unit for recording the contents of the first recording medium onto the storage unit, and storing unit for storing information regarding each track on the first recording medium as recording history information in the apparatus at the time the contents of the first recording medium are recorded onto the storage unit by the recording unit, as variously recited in Claims 1, 3, and 4 of the present application. Neither reference discloses recording the contents of a recording medium onto a storage unit of the apparatus.

The Ichimura et al. reference does not disclose the recording of content of a recording medium onto a storage unit of the apparatus. But rather, as is depicted in Figures 4A-4C and the corresponding description thereof in the specification, the Ichimura et al. reference describes copying content from disc 1 to disc 2. In the Ichimura et al. reference, the information is stored on the disc itself, so that a user cannot make unauthorized copies, for example, by simply copying the disc a first time using a first computer and then copying the disc a second time using a different computer. Thus, not only does the Ichimura et al. reference not teach the recording of content and storing of information, but, as a result, the

Ichimura et al. reference cannot determine whether a track on the first recording medium was previously recorded or not *onto the storage unit* by the recording unit based on the recording history information *stored in the apparatus*.

The Applicants submit that the Berman et al. reference also does not disclose or suggest the above features absent from the teachings of the Ichimura et al. reference.

The Berman et al. reference describes a playback unit that retrieves audio data from a remote server and plays them back in real time, using a home audio system, in response to user selection. The Berman et al. reference expressly indicates that the unit does not require an electromechanical storage device such as a disk drive, and that the user is provided with no permanent copy of the audio material, in order to ensure protection of copyrighted material. (Column 6, lines 14-31.) Thus, there is clearly no teaching in the Berman et al. reference of recording of content onto a storage unit of the apparatus and storing of information in the apparatus, and, as a result, the Berman et al. reference cannot determine whether a track on the first recording medium was previously recorded or not *onto the storage unit* by the recording unit based on the recording history information *stored in the apparatus*.

Accordingly, the Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent Claims 1, 3, and 4. Thus, the Applicants respectfully request the withdrawal of the obviousness rejection of Claims 1, 3, and 4.

Independent Claim 14 advantageously recites an information processing apparatus for

transferring contents from a first recording medium to a second recording medium, the apparatus comprising, among other features, means for selecting a portion or portions of the contents for recording from the first recording medium to the second recording medium, and means for displaying a list indicating the selected portion or selected portions and a non-selected portion or non-selected portions of the contents, wherein the selecting means initially, automatically selects portion or portions of the contents of the first recording medium for recording that do not have recorded history information present in the apparatus, and wherein the selecting means initially does not select portion or portions of the contents of the first recording medium for recording that have recorded history information present in the apparatus. Similar features are recited in Claims 18 and 22. The Applicants submit that the cited reference, either when taken singularly or in combination, fail to disclose or suggest the above features.

The cited references, either when taken singularly or in combination, fail to disclose or even suggest a display means that displays a list indicating the selected portion or selected portions and a non-selected portion or non-selected portions of the contents, wherein the selecting means initially, automatically selects portion or portions of the contents of the first recording medium for recording that do not have recorded history information present in the apparatus, and wherein the selecting means initially does not select portion or portions of the contents of the first recording medium for recording that have recorded history information present in the apparatus, as variously recited in Claims 14, 18, and 22 of the present application. The Official Action notes that the Ichimura et al. reference fails to disclose what information is displayed on the display thereof, and the selection means. The Official Action

supplements this deficiency with a teaching in the Berman et al. reference in column 13, line 50, through column 14, line 10. However, the Berman et al. reference does not disclose the display of a list indicated selected portion(s) for recording and non-selected portion(s), which are initially selected or not selected based on whether recorded history information is present or not in the apparatus. The Berman et al. reference does not determine whether a track was downloaded previously or not, and therefore cannot initially indicate such a track as being selected for recording or not, or display a list as variously recited in Claims 14, 18, and 22.

Furthermore, the Mori et al. reference does not supplement the deficiencies in the teachings of the Ichimura et al. reference and the Berman et al. reference discussed above. The Mori et al. reference does not disclose the display of a list indicated selected portion(s) for recording and non-selected portion(s), which are initially selected or not selected based on whether recorded history information is present or not in the apparatus. The Official Action cites column 37, lines 5-10, of the Mori et al. reference, which discusses an autoplay feature, as a teaching of the means for selecting recited in the claims. However, the autoplay feature is not a selection *for recording* (the audio is not being recorded) based upon the presence or not of *recorded history information in the apparatus*. The audio plays regardless of the presence or not of recorded history information in the apparatus. If the Official Action is suggesting that the autoplay is selected based on the presence of the software used to support the autoplay, then the Applicants want to note that clearly if such software is not present then the autoplay cannot be "selected." The claims recite that the selecting means initially *selects* portions of the contents of the recording medium for recording that *do not have* recorded history information present in the apparatus.

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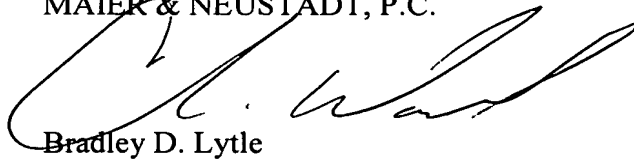
Accordingly, the Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent Claims 14, 18, and 22. Thus, the Applicants respectfully request the withdrawal of the obviousness rejections of Claims 14, 18, and 22.

The dependent claims are considered allowable for the reasons advanced for the respective independent claim from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

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